

REMARKS

This paper is submitted in response to the office action the Office mailed on September 15, 2005.

5 The amendments to the specification update the cross-reference to related applications and corrects errors. Amendments to the claims respond to the restriction requirement as discussed below. The amendments introduce no new matter.

Applicants listed commonly owned copending applications in information disclosure statements that Applicants mailed on June 10, 2005 and July 12, 10 2005. The publication numbers for those applications are US 2005/0075321 A1, US 2004/0043973 A1, US 2005/0101581 A1, US 2004/0220114 A1, US 2004/0138187 A1, US 2004/0116359 A1, US 2004/0097406 A1, US 2003/0083231 A1 and US 2003/0060425 A1. The Office did not initial those 15 references. The Office's attention is directed to these applications for consideration of any matter, e.g., nonstatutory double patenting (which is discussed below), that may be considered germaine to the prosecution of the claims in this application. Applicants also resubmit several references that the Office asserted were not included with prior information disclosure statements.

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Restriction and election

The Office clarified the restriction previously issued. Applicants elected the subject matter of claim 28, which claims a single compound $3\alpha,17\beta$ -dihydroxy-19-norandrost-4-ene for treating osteoporosis. New claim 37 corresponds to 25 claim 28 and claims the same subject matter. The new claims are amended to conform the scope of compounds to compounds where R^9 is $-\text{CHR}^{10}-$, which corresponds to group I that is described at page 5 of the office action. Applicants believe that the new claims and the election of new claim 37 meets the requirement to select a single species and a single clinical condition.

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Nonstatutory double patenting

The Office provisionally rejected claims 25-28 under the judicially created obviousness-type double patenting over claims 1-10, 15-19, 22 and 23 of copending application No. 10/877,911. Applicants respectfully traverse the
5 rejection and note that this rejection is not procedurally ripe for consideration. Because of this, Applicants request the Office to hold this provisional rejection in abeyance until patentable subject matter is identified in either or both of these applications. The filing of a terminal disclaimer at this time is premature. Once patentable subject matter is identified, Applicant can properly address this issue,
10 the terms of which will depend on the scope of allowable subject matter in these applications.

35 U.S.C. § 112, first paragraph

The Office rejected claims 23-28 as allegedly not enabled for the
15 prevention of osteoporosis. Applicants have amended the claims without prejudice to recite treatment and not prevention, so the rejection should be moot. Applicants reserve their right to file a continuing application to cover this subject matter. Applicants request reconsideration and withdrawal of the rejection.

35 U.S.C. § 102(b)

The Office rejected claims 23-28 as allegedly anticipated by Kousteni et al., *Science* 298:843-846 2002 (of record, hereafter 'Kousteni'). Applicants respectfully traverse the rejection. This divisional application claims priority from application Serial No. 09/535,675, filed March 23, 2000, now patent No.

25 6,667,299 B1. Because the Kousteni reference published in 2002, it is not prior art against the present claims under 35 U.S.C. § 102(b). Applicants request reconsideration and withdrawal of the rejection.

35 U.S.C. § 103(a)

30 The Office rejected claims 23-28 as allegedly unpatentable over Kousteni et al., *Science* 298:843-846 2002 (of record). Applicants respectfully traverse the rejection. This divisional application claims priority from application Serial No.

09/535,675, filed March 23, 2000, now patent No. 6,667,299. Because the Kousteni reference published in 2002, it is not prior art against the present claims under 35 U.S.C. § 103(a). Applicants respectfully request reconsideration and withdrawal of the rejection.

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Conclusion

Please charge any additional fees that are needed, or credit any overpayment to Deposit Account No. 501536.

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Respectfully submitted,

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15 Date: October 5, 2005

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